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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,456	03/25/2004	John B. McAdams	315-101P-WLK	4857

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EXAMINER

SUHOL, DMITRY

ART UNIT	PAPER NUMBER
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3725

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/808,456	MCADAMS ET AL.	
	Examiner	Art Unit	
	Dmitry Suhol	3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-16, 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 1 and 20, the limitation of "...normal-sized printed text..." was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. It does not appear that there is any support in the original disclosure of any particular sized text. Also with respect to claim 20, the limitation of "...normal format..." was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. It does not appear that there is any support in the original disclosure of any particular format.

Regarding claim 4, the limitation of "...is also interlineated..." was not described in the specification in such a way as to reasonably convey to one skilled in the relevant

art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In applicants specification at page 8, it is clearly stated that an interlineated bar code with printed text is an alternative embodiment, thus the combination of the embodiment of a bar code in the margin area with a bar code interlineated with the printed text is considered new matter since applicants DO NOT disclose that the two embodiments may be combined (as currently claimed).

Regarding claim 5, the limitation of "...is also overprinted..." was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In applicants specification at page 8, it is clearly stated that an overprinted bar code relative the printed text is an alternative embodiment, thus the combination of the embodiment of a bar code in the margin area with a bar code overprinted relative the printed text is considered new matter since applicants DO NOT disclose that the two embodiments may be combined (as currently claimed).

Regarding claim 8, the limitation of "...emulates the entire said printed text on one side of said at least one page..." was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no disclosure of such a relationship in applicants specification.

Regarding claim 10, the limitation of "...emulates said printed text located on at least one side of said at least one page..." was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at

the time the application was filed, had possession of the claimed invention. There is no disclosure of such a relationship in applicants specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 19-20 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Swartz et al '418. Swartz discloses device for scanning and audio generation from printed material containing all of the claimed elements including printed text and an associated high density multidimensional type bar code for blind people where the printed text is normal sized and in normal format (figure 3 and col. 4, lines 27+).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 rejected under 35 U.S.C. 103(a) as being unpatentable over Lemelson et al '656 in view of Swartz et al '418. Lemelson discloses a device for scanning and audio generation from printed material containing most of the claimed

elements, including with reference to claims 1, 17 and 19, a support medium including as least one page (book 2), printed matter including normal-sized printed text configured for a sighted person printed on at least one page (pictures and written text disclosed in col. 3, line 61), a bar code printed on the page (bar code 4), the bar code oriented parallel to an edge of at least one page and located within the margin of the page (figures 1 and 2 and col. 3, lines 59-61), the bar code emulating the printed text (col. 7, lines 37-41) and configured to be scanned by a hand held scanner (60). A machine reading device including a hand held scanner, as required by claim 2, is shown as scanning device 60 in figure 4. The bar code being configured such that it is read top to bottom, as required by claim 3, is shown in figures 1 and 2. The medium being a book, as required by claim 6, is shown as book 2 in figures 1 and 2. The relationship of the bar code and printed matter as required by claims 8 and 10 is described in col. 7, lines 37-41. The relationship of the bar code and at least one picture, as required by claim 9, is shown in figures 1 and 2.

Lemelson fails to explicitly teach that his bar code is a Braille linear high density multidimensional type barcode (2-D as required by claim 15) as required by claims 1 and 17. However, Swartz discloses a device which converts bar code data into audible sounds (used for blind people col. 4, lines 59-62) which teaches that it is known to use a variety of bar codes including a Braille type linear high density multidimensional type barcode (col. 4, lines 27+). Therefore it would have been obvious to one having ordinary skill in the art, at the time of the claimed invention to have utilized a Braille type linear high density multidimensional type barcode (including a 2-D bar code) since the use of

a particular type bar code would only depend on the amount of information to be stored and conveyed, especially since Lemelson clearly states that he envisions for his device to be utilized by the handicapped (col. 1, lines 57-61). Furthermore, the specific bar code dimensionality is considered to be a design choice in that applicants disclose that the bar code used in their invention may be of any type desired (page 12, lines 12-14 and page 18, lines 6-8).

Regarding the positioning of the Braille type bar code, as required by claims 1-5, 7, 12-14, and the additional printed matter as required by claim 1. It would have been obvious to one having ordinary skill in the art at the time of the claimed invention to place the Braille type bar code in any location on the page since it would only depend on the intended use of the assembly and the desired information to be displayed and since Lemelson states that the bar code of his invention may be placed in rows or columns anywhere on the pages provided that it does not interfere with the printed text. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of placement for the Braille code does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter (e.g. Braille bar code location or additional printed matter) and the substrate (support medium) which is

required for patentability. Additionally the location of the placement of the Braille bar code is considered to be a design choice since applicants do not disclose any advantage or criticality for such placement and it would appear that the device would work equally well no matter the positioning of the bar code (see applicants specification page 15, lines 15-20).

Regarding the dimensionality of the Braille bar code as required by claims 1, 11 and 15-17 and 19, it would have been obvious to one having ordinary skill in the art, at the time of the claimed invention to have manufacture the bar codes of Bail as a two or three dimensional bar code for the purpose of holding varying amounts of information and since the examiner takes official notice that such bar code construction is well known in the art. Furthermore, the specific bar code dimensionality is considered to be a design choice in that applicants disclose that the bar code used in their invention may be of any type desired (page 12, lines 12-14 and page 18, lines 6-8).

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lemelson et al '656 and Ueno '750, as stated above, and further in view of Freeman '375. Lemelson, as modified by Ueno, fails to explicitly teach a bar code interlineated relative to lines of printed matter as required by claim 4 and the bar code being overprinted relative to the printed matter as required by claim 5. However, Freeman discloses a device like that of Lemelson which clearly teaches that providing a layout a bar code which is interlineated relative printed text is known in the art (figures 1-2) as well as a bar code which is overprinted relative to the printed text (col. 8, lines 14-21)

and since Lemelson states that the bar code of his invention may be placed in rows or columns anywhere on the pages provided that it does not interfere with the printed text (col. 3, lines 61-64) it would have been obvious to provide the book of Lemelson, as modified by Ueno, with a layout such that the bar code is interlineated or overprinted with the text for the purpose of easily corresponding and audible output produce by the barcode with the associated printed text in an non-interfering manner.

Response to Arguments

Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection. However, the examiner does wish to point out that as stated above and in the previous rejections the placement of the bar code along a particular margin and the information it carries is not patentable as CLEARLY directed by the courts. *In re* Gulack 217 USPQ 401, (CAFC 1983). Furthermore, the placement of the bar code in the particular margin and the type of bar code is clearly a design choice in that applicants admit that their invention would function just as well with many other types of bar code positioning and bar code types (see above rejection for appropriate pages of applicants specification).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 571-272-4430. The examiner can normally be reached on Mon - Friday 8:30am-5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Dmitry Suhol
Examiner
Art Unit 3725

ds